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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/542,200

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Toshihiro Ito

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EXAMINER

HANRAHAN, JOSEPH M.J.

ART UNIT

PAPER NUMBER

1794

NOTIFICATION DATE

DELIVERY MODE

02/24/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/542,200	Applicant(s) ITO ET AL.	
	Examiner JOSEPH M.J. HANRAHAN	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/08/2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/21/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, and 7-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Misaki US Patent 4,765,996.

3. Referring to Claims 1 and 7, Misaki teaches rice or barley (column 1, lines. 7-8) coated with vitamins (column 2, lines. 43-45) and an iron salt (column 9, line 47) that have further been coated with an emulsifying agent (column 9, line 49). Misaki also teaches rice that has been coated with hydrogenated oil (column 2, lines 56-57) and glycerol fatty acid esters (column 2, line 65). The iron salt and vitamin composition in Misaki is not coated with an emulsifying agent before it is applied to the rice or barley. However, the process of treating the iron salt and vitamin composition with the emulsifying agent does not render a different end product. The final product is still rice or barley coated with vitamins, and iron salt, hydrogenated oil, and an emulsifying agent. Furthermore, the present invention specification does not indicate that coating the iron salt and vitamins with an emulsifier imparts any special qualities or characteristics. Therefore, Misaki anticipates Claim 1.

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4. Referring to Claim 2, Misaki teaches rice or barley (column 1, lines. 7-8) coated with an iron salt (column 9, line 47), hydrogenated oil (column 2, lines 56-57) and glycerol fatty acid esters (column 2, line 65).

5. Referring to Claims 3 and 8, Misaki teaches rice or barley (column 1, lines. 7-8) coated with vitamins (column 2, lines. 43-45) and an iron salt (column 9, line 47) that have further been coated with an emulsifying agent (column 9, line 49). Misaki also teaches rice that has been coated with hydrogenated oil (column 2, lines 56-57) and glycerol fatty acid esters (column 2, line 65). The iron salt and vitamin composition in Misaki is not coated with an emulsifying agent before it is applied to the rice or barley. However, the process of treating the iron salt and vitamin composition with the emulsifying agent does not render a different end product. The final product is still rice or barley coated with vitamins, and iron salt. Furthermore, the present invention specification does not indicate that coating the iron salt and vitamins with an emulsifier imparts any special qualities or characteristics. Therefore, Misaki anticipates Claim 3.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Misaki's US Patent 4,765,966. Misaki discloses all the limitations of the parent claims as described above, but does not explicitly disclose the particle sizes of iron salts. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ an iron salt with a particle diameter of 2 μm or less, since such a modification would have involved a mere change in size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *Gardner*

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v. TEC Systems, Inc., 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied , 469 U.S. 830, 225 USPQ 232 (1984).

Response to Arguments

1. Applicant's arguments filed 12/08/2008 have been fully considered but they are not persuasive.
2. The applicant argues that the Misaki '996 reference fails to disclose or suggest the enriched rice or barley has an emulsifying agent-coated iron salt composition as claimed.
3. The examiner disagrees. Misaki teaches a final product that is rice or barley coated with vitamins, and iron salt, hydrogenated oil, and an emulsifying agent; not iron alone. Therefore, the final product of Misaki contains an emulsifying agent-coated iron salt composition as claimed.
4. The applicant further argues by way of a Rule 132 Affidavit, that the product of Misaki and the claimed invention are in fact different.
5. The examiner disagrees.
6. The rice of the present invention and that of the Misaki '996 reference are not different as the present invention is currently claimed. The experimental results offered in applicants' 37 C.F.R. 132 affidavit do not reconcile the present claims' failure to delineate the differences between themselves and Misaki. For example, the experimental results do indicate that differences exist between enriched rice 1 and 2 and 3 and 4. That difference is very likely due to the additional 20g of emulsifiers (as

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given in Example 1 of applicants' specification) that are used to coat the iron salt composition in examples 2 and 4. However, this difference is not reflected in applicants' claims.

7. Applicant argues that the Graham factor of ascertaining the difference between the prior art and the claim at issue has not been resolved.

8. The examiner disagrees. The examiner indicated in the prior action that Misaki discloses all the limitations of the claims, but does not explicitly disclose the particle sizes of iron salts. As explained above, the evidence and arguments provided are not persuasive in showing that a difference between Misaki and the claims at issue does in fact exist. Therefore, the examiner maintains that the Misaki fails only to disclose the particle size of the iron salts.

9. Applicant argues that the rationale in combining the references is improper.

10. The examiner disagrees. Only one reference was used in the 103 rejection and so combination is not an issue.

11. The applicant argues that the examiner the Graham factor of unexpected results lies in applicants favor.

12. The examiner disagrees. The 103 rejection was based on the obviousness of selecting the particle size of the iron salt composition and not the results shown by Table 2 at page 25. As stated in the previous action, selecting the size of a component is regarded as being within the ordinary level of skill in the art.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSEPH M.J. HANRAHAN whose telephone number is (571) 270-7060. The examiner can normally be reached on M-F from 10:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David R. Sample/
Supervisory Patent Examiner, Art Unit 1794

/JOSEPH M.J. HANRAHAN/
Examiner, Art Unit 1794
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